

REMARKS:

- 1) The Examiner's attention is directed to the following formal matters to be approved or acknowledged when next examining this application:
  - a) please approve the formal drawings filed with the application on March 15, 2002;
  - b) please acknowledge the foreign priority claim, and receipt of the priority document which was forwarded to the USPTO by the PCT International Bureau in the PCT handling of this application; and
  - c) please consider the references cited in our Information Disclosure Statement of March 15, 2002, and accordingly return an initialed, signed and dated acknowledgment copy of the Form PTO-1449.
- 2) Referring to section 1 on page 2 of the Office Action, in response to the Restriction Requirement, **applicant hereby elects the group I claims 1, 2, and 13 to 17 directed to an indexable insert, for examination.**
- 3) The Restriction Requirement is respectfully traversed on the following grounds. The non-elected claims 8 to 11 and 18 are directed to a method of making the particular elected insert. Claim 8 has now been amended into dependent form so as to depend from claim 1 and recite a particular method of making the elected product of claim 1. The remaining method-of-making claims 9 to 11 and 18 all depend from claim 8.

- 4) In view of the dependence of amended method-of-making claim 8 from elected claim 1, the subordinate non-elected Group II now relates to a single general inventive concept with Group I, because it shares the same special technical features as its parent independent claim 1. The elected claim 1 defines a particular product, and non-elected claim 8 defines a process that is specially adapted for the manufacture of that particular product. This is necessarily the case because claim 8 now depends from and thus incorporates all the limitations of claim 1. In this regard, see the PCT Administrative Instructions, Annex B, Unity of Invention, Part 1, Section (e). Also see MPEP §821.04 and §2116.01, which make clear that it is proper to rejoin a non-elected method-of-making claim that depends from or otherwise incorporates all the features of an elected product claim.
- 5) For the above reasons, rejoinder of the non-elected method-of-making claims 8 to 11 and 18 is respectfully requested.
- 6) Referring to section 3 on pages 2 to 3 of the Office Action, **applicant hereby elects Species A directed to the alloy set forth in claims 9 and 14 for examination.**
- 7) Among the above elected product claims 1, 2, and 13 to 17, **claims 1, 2, 13, 14 and 17 read on the elected Species.** Particularly, elected claim 14 specifically reads on the elected Species A to the exclusion of Species B and C. Claims 1, 2 and 13 are generic

to all of the Species A, B, C, and D. Also, claim 17 specifically reads on Species D but is generic with respect to Species A, B, and C (i.e. claim 17 also reads on an indexable insert having the bonding layer composition according to elected Species A, because claim 17 relates to a coating layer composition and has no limitation as to the bonding layer composition).

- 8) The Election Requirement is respectfully traversed with respect to Species D, because Species D relates to the composition of a coating layer while Species A, B, and C relate to the composition of a bonding layer. Thus, Species D on the one hand and Species A, B, and C on the other hand are not mutually exclusive of each other, but rather are unrelated and generic relative to each other. For example, Species A, B and C could all be dependent from Species D, or vice versa.
- 9) After rejoinder of the non-elected method-of-making claims, claim 8 is generic to all Species, claim 9 specifically reads on the elected Species, and claim 18 generically reads on the elected Species A while also specifically reading on the non-elected Species D.
- 10) In the event a generic claim is ultimately found allowable, rejoinder, consideration and allowance of the non-elected claims depending from such an allowable generic claim are respectfully requested.


- 11) Favorable consideration and allowance of the application, including all present claims 1, 2, 8 to 11, and 13 to 18, are respectfully requested.

Respectfully submitted,

Yasuyuki Kanada et al.  
Applicant

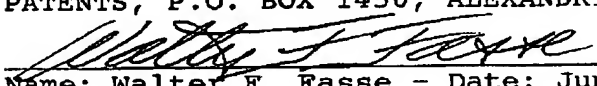
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 6/20/03  
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